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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/294,656	
	Filing Date	4/19/99	
	First Named Inventor	M. Cusson	
	Group Art Unit	2772	
	Examiner Name	R. Ho	
Total Number of Pages in This Submission	4	Attorney Docket Number	oracle01.001

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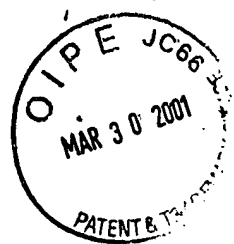
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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5 **Applicant:** M. Cusson, et al. **Paper No.:** 13
 Application No: 09/294,656 **Group Art Unit:** 2772
 Filed: 4/19/99 **Examiner:** R. Ho
10 **Title:** *Web servers with queryable dynamic caches*

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Response to restriction requirement

Summary of the prosecution

20 Applicants received a restriction requirement mailed 18 Dec. 2000 to which they
 responded on 6 Jan. 2001 with a response that made the required election and further
 amended the application by adding new claims that were dependent from certain of the
25 elected claims. The new claims contained subject matter from certain of the non-elected
 claims.

 Examiner mailed a new restriction requirement on 1 Mar. 2001 in which she indicated
 that Applicants' response of 6 Jan. 2001 was non-responsive because it added claims.
 Applicants' attorney can find nothing in the patent statute, 37 C.F.R., or the MPEP which
30 indicates that amendments are barred in a response to a restriction requirement.
 Applicants are consequently traversing the restriction requirement of 1 Mar. 2001 in its
 entirety.

Adding claims in response to a restriction requirement

35 Restriction requirements are governed by 37 C.F.R. 1.142, which requires only that the
 Applicant elect the invention he or she wishes to have examined. The non-elected claims
 are withdrawn from consideration. Applicants did exactly what is required by 37 C.F.R.

1.142 in their response of Jan. 6: they elected claims 1-7, 9-20, 24-48, and 53-95 and cancelled claims 21-23, 49-52, and 96-99 without prejudice. There is nothing in 37 C.F.R. 1.142 that prohibits adding additional claims.

5 In her new restriction requirement of 1 Mar. 2001, Examiner cited 37 C.F.R. 1.111 and MPEP §818 and §818.02(a) in support of her contention that new claims cannot be added in a response to a restriction requirement. 37 C.F.R. 1.111 does not deal specifically with restriction requirements and requires only that the applicant reply to the Office action. As just pointed out above, Applicants did reply to the restriction requirement of Dec. 18
10 exactly as set forth in 37 C.F.R. 1.142. 37 C.F.R. 1.111 further sets forth that the Applicant may request further examination, "with or without amendment" (37 C.F.R. 1.111(a)).

MPEP §818 sets forth only the minimum requirements for a response to a restriction
15 requirement. Applicants have already described how they satisfied those requirements with regard to the restriction requirement of 18 December. MPEP §818 is completely silent as to whether an amendment to the claims may accompany a response to a restriction requirement. MPEP §818.02(a) simply states

20 where claims to another invention are properly added and entered in the case before an action is given, they are treated as original claims for the purposes of restriction only. . . . subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP §821.03

MPEP §818.02(a) thus does not prohibit the addition of claims in response to a restriction
25 requirement; it only indicates that the new claims may also result in a restriction requirement, as provided in MPEP §821.03. MPEP §821.03 quotes 37 C.F.R. 1.45 to indicate that when an applicant presents claims that are distinct from and independent of the invention previously claimed, a restriction requirement will result.

30 What all of this amounts to is that claims may be added in a response to a restriction requirement and that a restriction requirement with regard to the added claims may only

be made if the added claims are to an invention is "distinct from and independent of" the invention previously claimed.

New claims 106-111 not subject to restriction

5 The difficulty with applying a restriction requirement to new claims 106-111 is that these claims *are dependent from elected claims*. They thus cannot be "distinct from and independent of the invention previously claimed", as required for the restriction. As dependent claims, the new claims fall within the ambit of 37 C.F.R. 1.141(a), which specifically states,

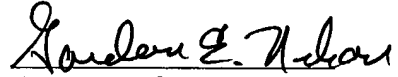
10 Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and *all the claims to species in excess of*
15 *one are written in dependent form* or otherwise include all of the limitations of the generic claim. (emphasis added)

The generic claims are what MPEP §809.03 terms *linking claims*. The procedure that MPEP §809.03 sets forth when there are linking claims is that the restriction is made
20 subject to the nonallowance of the linking claims. Upon allowance of the linking claims, the restriction requirement is to be withdrawn.

Conclusion

Applicants have demonstrated that their response to Examiner's restriction requirement of 18 December properly made an election and was therefore completely responsive to the restriction requirement. They have further demonstrated that nothing in 35 U.S.C., 37 C.F.R., or the MPEP prohibits an applicant who has properly responded to a restriction requirement from adding new claims in addition to responding to the restriction requirement. Finally, they have demonstrated that the added claims are dependent from elected claims and that Examiner can therefore at most make a conditional restriction requirement as set forth in MPEP §809.03. Applicants consequently respectfully request that Examiner accept Applicants' response of 6 Jan. 2001 as being fully responsive, enter the amendment made in the response of 6 Jan. 2001, and continue the examination of the application on the basis of that amendment.

Respectfully submitted,



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